

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VALENTIN PANAYOTOV

Appeal 2007-1663
Application 09/705,578¹
Technology Center 2100

Decided: September 7, 2007

Before JOHN C. MARTIN, HOWARD B. BLANKENSHIP, and SCOTT R. BOALICK, *Administrative Patent Judges*.

BOALICK, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-10, all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

¹ Application filed November 3, 2000. The real party in interest is Agere Systems Inc.

STATEMENT OF THE CASE

Appellant's invention relates to a communication protocol for data exchange between two computer applications using shared files. In the words of the Appellant:

The present invention concerns a system and associated method for exchanging data between computer applications via shared file structures and a pre-defined flow sequence. The applications utilize basic input/output functionality. For each communication link, one data file and two notification files are used.

A computer application data file receives data from the first computer application. A computer application send file receives notification when the computer application data file has received data from the first computer application. A computer application read file receives notification when data has been read from the computer application data file by the second computer application. The first computer application monitors the computer application read file for notification from the second computer application to initiate further writing to the computer application data file.

(Specification 4:24 to 5:6.)

Claim 1 is exemplary:

1. A computing system for exchanging data between a first computer application of the system and a second computer application of the system, comprising:

a computer application data file for receiving data from the first computer application;

a computer application send file for receiving notification when the computer application data file has received data from the first computer application;

a computer application read file for receiving notification when data has been read from the computer application data file by the second computer application, the first computer application monitoring the computer application read file for notification from the second computer application to initiate further writing to the computer application data file.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Wu US 6,633,924 B1 Oct. 14, 2003
(filed Oct. 2, 1997)

Creemer US 6,671,700 B1 Dec. 30, 2003
(filed May 23, 2000)

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being obvious over Creemer and Wu.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the Brief and the Answer for their respective details. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to

make in the Brief have not been considered and are deemed to be waived.

*See 37 C.F.R. § 41.37(c)(1)(vii) (2004).*²

ISSUE

The issue is whether Appellant has shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). That is, given the teachings of the prior art, has Appellant shown that the differences between the claims and the prior art are sufficient to render the claimed subject matter unobvious to a person skilled in the art at the time the invention was made?

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Creemer describes a system for sharing information between a host computer system and a peripheral computer system (such as a "palmtop" computer system) using conduit programs running simultaneously on the host system to synchronize information between the two computer systems. (Col. 2, l. 65 to col. 3, l. 2.) Creemer teaches that a user may wish to synchronize applications such as an appointment book, an address book, and an electronic notepad application. (Col. 1, l. 66 to col. 2, l. 2.) The conduits taught

² Except as will be noted in this opinion, Appellant has not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See 37 C.F.R. § 41.37(c)(1)(vii)*.

by Creemer use interleaved requests to transfer information across a single communications link between the two computer systems -- i.e., the conduits use time multiplex transfers. (Col. 3, ll. 2-6.) When one conduit is performing a transfer task over the communication link, the other conduits can perform non-transfer tasks. (Col. 3, ll. 6-9.) If more than one conduit requests use of the communication link at the same time, an arbitration process is used to determine the order of access. (Col. 3, ll. 9-12.) In particular, Creemer teaches that an ordering program 412 is used to establish the order of conduit access to the communication link 55, and the ordering program 412 may be an arbitrator or other method for ordering access to the communication link. (Col. 8, ll. 1-7; Fig. 9; *see also* col. 8, l. 60 to col. 9, l. 9.) The conduits may synchronize records between databases on the two computer systems, or may load software or synchronize e-mail between the two computer systems. (Col. 3, ll. 12-17.)

2. Wu describes a method for synchronizing objects between a first and a second object store, such as synchronizing databases used in personal information managers (PIMs) used on two different computers (e.g., a desktop computer and handheld computer (H/PC)). (Abstract; col. 1, ll. 7-10.) Wu uses a synchronization manager to maintain a reference store with identifying data segments corresponding to objects that have previously been synchronized. (Abstract; col. 7, ll. 27-31.) Interfaces to an application program that maintains the first and second data store allow the synchronization manager to compare objects. (Abstract; col. 6, ll. 57-61.) Wu teaches

that an interface determines if an object has been changed in the first data store (e.g., on the desktop computer) since the last synchronization, and if so the synchronization manager takes steps to update the corresponding object in the second data store (e.g., on the handheld computer). (Abstract; col. 9, ll. 47-64; col. 10, ll. 60-63.) If the object has changed in the second data store since the last synchronization, then the synchronization manager updates the corresponding object in the first data store. (Abstract; col. 10, ll. 9-21, 54-60.)

3. Wu teaches that the synchronization manager 82 can reference a particular object by using a "handle," which is an identifier that enables uniquely identifying and accessing the object. (Col. 8, ll. 9-13.) The "synchronization manager 82 needs to obtain a list of handles corresponding to the objects stored in desktop object store 18 before it can perform any significant synchronization tasks." (Col. 8, ll. 21-24.) "After obtaining handles, synchronization manager 82 determines a correspondence between the provided handles and object identifiers used by H/PC PIM 22, with reference to reference store 84." (Col. 8, ll. 26-29.)
4. Wu teaches that, "[i]n some cases, an object will have changed in both object stores. If so, the user is prompted to resolve the conflict by deciding which modification should be retained." (Col. 10, ll. 64-66.)

PRINCIPLES OF LAW

All timely filed evidence and properly presented arguments are to be considered by the Board in resolving an obviousness issue on appeal. *See In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

In the examination of a patent application, the Examiner bears the initial burden of showing a *prima facie* case of unpatentability. *Id.* at 1472, 223 USPQ at 788. When that burden is met, the burden then shifts to the applicant to rebut. *Id.*; *see also In re Harris*, 409 F.3d 1339, 1343-44, 74 USPQ2d 1951, 1954-55 (Fed. Cir. 2005) (finding rebuttal evidence unpersuasive). If the applicant produces rebuttal evidence of adequate weight, the *prima facie* case of unpatentability is dissipated. *In re Piasecki*, 745 F.2d at 1472, 223 USPQ at 788. Thereafter, patentability is determined in view of the entire record. *Id.* However, on appeal to the Board it is an appellant's burden to establish that the Examiner did not sustain the necessary burden and to show that the Examiner erred -- on appeal we will not start with a presumption that the Examiner is wrong. *See In re Rouffet*, 149 F.3d 1350, 1355 47 USPQ2d 1453, 1455 (Fed. Cir. 1998) ("On appeal to the Board, an applicant can overcome a rejection [for obviousness] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.").

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is

resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). See also *KSR*, 127 S. Ct. at 1734, 82 USPQ2d at 1391 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls."). The Court in *Graham* further noted that evidence of secondary considerations, such as commercial success, long felt but unsolved needs, failure of others, etc., "might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." 383 U.S. at 18, 148 USPQ at 467.

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* at 1739, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248 [(1850)]," *KSR*, 127 S. Ct. at 1739, 82 USPQ2d at 1395 (citing *Graham*, 383 U.S. at 12, 148 USPQ at 464), and explained how its precedent illustrates the doctrine that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740, 82 USPQ2d at 1396.

The Supreme Court explained that:

[o]ften, it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

Id. at 1740-41, 82 USPQ2d at 1396. The Court noted that "[t]o facilitate review, this analysis should be made explicit." *Id.* at 1741, 82 USPQ2d at 1396 (citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness")). However, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.*

The Court noted that "[i]n many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends." *KSR*, 127 S. Ct. at 1741, 82 USPQ2d at 1396. "Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id.* at 1741, 82 USPQ2d at 1397. The Court also noted that "[c]ommon sense teaches . . . that familiar items may

have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *Id.* at 1742, 82 USPQ2d at 1397. "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *Id.*

During examination of a patent application, a claim is given its broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). "[T]he words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312, 75 USPQ2d 1321, 1326 (Fed. Cir. 2005) (en banc) (internal citations omitted). The "ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* at 1313, 75 USPQ2d at 1326.

ANALYSIS

Appellant contends that Examiner erred in rejecting claims 1-10 as being obvious over Creemer and Wu. Reviewing the findings of facts cited above, we agree. In particular, we find that the Appellant has shown that the Examiner failed to make a *prima facie* showing of obviousness with respect to claims 1-10 because Creemer and Wu do not teach or suggest each and every limitation of the claims.

Regarding independent claims 1 and 2, Appellant argues that the Examiner has failed to establish a *prima facie* case of obviousness because Creemer and Wu fail to teach or suggest application programs reading from

or writing to a computer application data file, a computer application send file, and a computer application read file, as claimed. (Br. 3-5.)

The Examiner found that Creemer discloses a computer application data file because it refers to synchronization of appointment books. (Answer 3, 6; FF 1.) The Examiner also found that Wu discloses a computer application send file because the synchronization manager on the handheld computer sets a status bit when an object has been changed in the data store on the handheld computer since the last synchronization. (Answer 7; FF 2.) In addition, apparently finding an equivalence between the claimed "computer application read file" and a desktop computer, the Examiner found that Wu discloses a computer application read file and "teaches synchronization manager 82 monitor [sic] the notification/handles from another application H/PC before synchronization to initiate writing." (Answer 7.)

While we agree with the Examiner that Creemer teaches a computer application data file and Wu teaches a computer application send file, we agree with Appellant that neither Creemer nor Wu teach or suggest the limitation of a computer application read file, as claimed. We do not find the Examiner's position that the desktop computer of Wu meets the recited computer application read file limitation to be reasonable. If the Examiner meant to refer to a particular file on the desktop computer of Wu rather than the desktop computer itself, we find no such file disclosed in Wu that would meet the recited computer application read file limitation. Although Wu teaches a status bit being reset when notification is received that an object has been synchronized, Wu does not teach or suggest that this status bit is

monitored by the desktop computer in order to initiate further writing of data. (FF 2.)

Also, contrary to the Examiner's finding, Wu does not teach that the synchronization manager 82 monitors a notification from another application before synchronizing. (*See* FF 3.) The cited portion of Wu teaches that the synchronization manager 82 must first obtain a list of objects stored in the desktop object store 18 before performing any significant synchronization tasks. (FF 3.) However, Wu does not teach that the list of objects is monitored by the synchronization manager for notification from another application to initiate further writing to a computer application data file.

Moreover, the Examiner has made no showing that the recited computer read file limitation is a predictable variation of the prior art. Nor has the Examiner made any showing that the recited computer read file limitation would be common sense or a creative step that a person of ordinary skill in the art would employ.

Therefore, we conclude that the Examiner erred in rejecting claims 1-2.

Appellant makes essentially the same arguments for claims 3-10, and we find that the Examiner erred in rejecting claims 3-10 for the same reasons as discussed with respect to claims 1-2.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner erred in rejecting claims 1-10 for obviousness under 35 U.S.C. § 103.

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DECISION

The rejection of claims 1-10 for obviousness under 35 U.S.C. § 103 is reversed.

REVERSED

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RYAN, MASON & LEWIS, LLP
90 FOREST AVENUE
LOCUST VALLEY NY 11560